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EXAMINER

OJINI, EZIAMARA ANTHONY

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/701,338

Applicant(s)

LUTZ, HELMUT

Examiner

Anthony Ojini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's cancellation of claim 4 in Paper No. 6 is acknowledged. Claims 6-9 depend on a canceled claim 4, and for the purpose of this office action, claims 6-9 will be treated as been depended on claim 1.

#### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the resilient material underside of the disk (3) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "2b" has been used to designate both container wall and container base in figure 2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,6,12,13,15, 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. (5,823,861).

**With respect to claims 1,6,12,** Kobayashi et al. disclose a grinding machine comprising a stationary container (1); a rotary disk (4) placed above a container base for forming a finite gap (S) with respect to the container wall (see fig. 2) the rotary disk being rotatable relative to the container, the rotary disk having a resilient material (2) at least on its underside (see fig. 2). Kobayashi et al. also disclose the size of the finite gap between the rotary disk and the container wall being smaller than the spacing of the disk from the container (see fig. 2).

**With respect to claim 2,** Kobayashi et al. disclose a driving shaft (9) of the grinding disk passes in liquid-tight manner through the base of the container (see fig. 2).

**With respect to claim 3,** Kobayashi et al. disclose the upper side of the disk is rigid (see col. 5, lines 49-50 & fig. 2).

**With respect to claim 13,** Kobayashi et al. disclose the disk has a raised circumferential edge (see fig. 2).

**With respect to claim 15,** Kobayashi et al. disclose the container is made from polyurethane (a form of thermoplastic) (see col. 4, lines 29-31).

**With respect to claims 25,27,** Kobayashi et al. disclose the disk has an upwardly inclined circumferential edge, an outer wall of the upwardly inclined circumferential edge following a contour of a portion container wall adjacent the upwardly inclined circumferential edge such that the finite gap has a constant width (see fig. 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5,7-11,14, 24,26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (5,823,861).

**With respect to claims 5,7,8,9**, Kobayashi et al. fails to disclose wherein the disk is made from resilient, flexible material; elastomeric plastic; rubber; felt; cotton fabric or resilient floor covering material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Kobayashi et al. with rotary disk that is made from resilient, flexible material; elastomeric plastic; rubber; felt; cotton fabric or resilient floor covering material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

**With respect to claim 10,11**, Kobayashi et al. fail to disclose the optimum value as claimed by the applicant.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Kobayashi et al. with the optimum value as claimed by the applicant, since it has been held that discovering an optimum value of a

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result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

**With respect to claim 14**, Kobayashi et al. fail to disclose a one-piece casing.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Kobayashi et al. with a one-piece casing, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

**With respect to claim 24,26**, Kobayashi et al. fail to disclose the optimum range as claimed by the applicant.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Kobayashi et al. with the optimum range as claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (5,823,861) in view of Lin (5,088,238).

**With respect to claims 16,20,21**, Kobayashi et al. fail to disclose a drive motor for the rotary disk is placed beneath the rotary disk and below the container and laterally of the container.

Lin discloses a drive motor (41) for the rotary disk (2) that is placed beneath the rotary disk and below the container and laterally of the container.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Kobayashi et al. with a drive motor for the rotary plate that is placed beneath the rotary disk and below the container and laterally of the container in view of Lin so as to ensure a smooth rotation of the drive shaft and the rotary disk.

**With respect to claims 17-19**, Kobayashi et al. fail to disclose a drive for the disk has a gear between the drive motor and disk wherein the gear is positioned below the disk and wherein the drive is constructed as a gear motor integrated gear.

Lin discloses a drive for the disk has a gear set (44) between the drive motor (41) and the rotary disk (2) disk wherein the gear is positioned below the disk, and wherein the drive is constructed as a gear motor integrated gear.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Kobayashi et al. with a gear set that is between the drive motor and the rotary disk wherein the drive is constructed as a gear motor integrated gear in view of Lin so as to ensure a smooth rotation of the drive shaft and the rotary disk.

**With respect to claim 22**, Kobayashi et al. fail to disclose a motor is substantially at the same level as the top of the container.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Kobayashi et al. with a motor that is

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substantially at the same level as the top of the container, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (5,823,861) in view of Nishimura et al. (5,476,415) and Takemoto et al. (5,487,696).

**With respect to claim 23**, Kobayashi et al. fail to disclose a sealable outlet provided below the disk in the base of the container.

Nishimura et al. disclose a dry barrel-finishing machine comprising an outlet (24) provided below a rotary plate (9) disk in the base of the container (1).

Takemoto et al. an apparatus having a sealable outlet (5,6) (see figs. 1,2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Kobayashi et al. with a sealable outlet provided below the disk in the base of the container in view of Nishimura et al. and Takemoto et al. so as to control flow of medium in the container through the outlet pipe.

### ***Response to Amendment***

Applicant's arguments filed 4/1/03 have been fully considered but they are not persuasive.

**Applicant argues** that U.S. Patent No. 5,279,074 to Davidson "does not disclose a rotary disk having a resilient material at least on its underside". However, Kobayashi et

al. disclose the concept of a grinding machine comprising a rotary disk having a resilient material (2) at least on its underside.

**Applicant argues** that Davidson "teaches away from using a rotary disk having a flexible material at least on its underside". However, Kobayashi et al. disclose in column 2, lines 1-10, the concept of a grinding machine comprising a rotary disk having a flexible material at least on its underside.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kobayashi et al. (6,379,233) and Gegenheimer (6,296,556) disclose centrifugal grinder respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Ojini whose telephone number is 703 305 3768. The examiner can normally be reached on 7.30 to 5.00 Tuesday-Friday with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703 308 2687. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1148.

A handwritten signature in black ink, appearing to read "AO pin".

AO  
October 28, 2003